

REMARKS

Request for Reconsideration

Applicants have carefully considered the matters raised by the Examiner in the outstanding Office Action but remain of the opinion that patentable subject matter is present. Applicants respectfully request reconsideration of the Examiner's position based on the above amendments to the claims, the Declaration of Mr. Sakai, a Terminal Disclaimer and the following remarks.

Claims Status

Claims 1, 6, 7, 9, 10, 13-15 and 18-22 are pending in this Application.

Claim 1 has been amended herein to delete the specific recitation to the types of metal salts of the fatty acid and Claim 22 has been added to specifically identify these limitations.

Claim 1 has also been amended to delete the specificity of the cleaning device and Claims 6, 9 and 10 have been amended to provide antecedent basis because of the amendment made to Claim 1. Claim 21 has also been

added to pick up some of the limitations which were deleted by deleting that portion of Claim 1 directed to the pressure used by the rubber blade. Respectfully, no new matter has been added by way of these amendments.

The amendments to Claim 1 are based on the fact that the data presented in Mr. Sakai's Declaration evidences the criticality of the combination of the average circular degree of the toner, the wax of the toner, and the number average of primary particle diameter of the silica used in the layer of the photoreceptor.

Double Patenting Rejections

The Examiner had rejected Claims 1, 9, 10, 13-15 and 18-20 on the grounds of non statutory obviousness-type double patenting based on Claims 1-3 and 27 of Itami in view of Nagase, Hagi and JP '417. Additionally, Claims 1, 6, 7, 9, 10, 13-15 and 18-20 had been rejected on the grounds of non statutory obviousness-type double patenting based on Claims 1-3 and 27 of Itami in view of Nagase, Hagi and Kurabayashi.

In order to respond to these two double patenting rejections, Applicants hereby submits a Terminal Disclaimer with respect to Itami. Respectfully, the double patenting rejections have now been overcome.

The government fee for the Terminal Disclaimer is being paid concurrently herewith.

Prior Art Rejection

Claims 1, 9, 10, 13-15 and 18-20 have been rejected as being unpatentable over a combination of Asano, JP '417, Uchida and Hagi. In the rejection, the Examiner uses Asano to teach the photoreceptor, JP '417 to teach the cleaning device, Uchida to teach the toner and Hagi to teach the external additives.

In order to respond to the Examiner's rejection, Applicants have performed tests in order to demonstrate the criticality of the combination of the specific toner and the specific photoreceptor as recited in the claims. More specifically, the tests which are presented by way of a Declaration of Mr. Sakai demonstrate that it is essential to have a toner with the average circular degrees recited in the claims and with a wax with the specific number of

carbon atoms as recited in the claims, in combination with a silica particle on the photoreceptor with the number average of particle size diameter as recited in the claims. As specified in Mr. Sakai's Declaration, the combination of these three provides surprising and unexpected results compared to the individual limitation.

Specifically, the Examiner's attention is directed to paragraphs 9 through 20 and Table 1 of Mr. Sakai's Declaration where he attests to the criticality of the three limitations and the unexpected nature of the combination of the three. Based on the statements made in Mr. Sakai's Declaration, it is submitted that Applicants have demonstrated the criticality of the three limitations and the patentability of the claims over cited references.

Specifically, the Examiner should view Table 1 and note the following:

- (1) Claimed Photoreceptor and Toner with wax and circular degree

Examples: 18-20, 23-25, 27-32

- (2) Claimed Photoreceptor and toner with wax, only
- Examples: 1-6

- (3) Claimed Photoreceptor and toner with circular degree only

Examples: 8-10, 13-15

- (4) Claimed toner with circular degree and wax, only

Examples: 17, 21, 22, 26

- (5) Claimed toner with circular degree, only

Examples: 7, 11, 12, 16

It can be seen that only the combination of all three provides superior results and such is surprising and unexpected as attested to by Mr. Sakai.

Respectfully, the claims are patentable over the references taken alone or in combination.

Request for Three-Month Extension of Time

Applicants hereby petition for a three month extension of time within which to respond to the outstanding Office Action and the fees associated with the three month extension is paid concurrently herewith.

Should any additional fees or extensions of time be necessary in order to maintain this Application in pending condition, appropriate requests are hereby made and authorization is given to debit Account #02-2275.

Conclusion

In view of the foregoing and the enclosed, it is respectfully submitted that the Application is in condition for allowance and such action is respectfully requested.

Respectfully submitted,

LUCAS & MERCANTI, LLP

By:


Donald C. Lucas, Reg. # 31,275
(Attorney for Applicant)
475 Park Avenue South
New York, New York 10016
Tel. # (212) 661-8000

DCL/mr

Attached: Executed Terminal Disclaimer
Executed Declaration of Mr. Sakai signed
on September 12, 2008.